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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/669,653
Filing Date: September 25, 2003
Appellant(s): NAKAMURA ET AL.

Theodore C. Shih
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/22/2009 appealing from the Office action mailed 2/22/2008.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,035,462	White et al.	4-2006
6,346,998	Shiota et al	2-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 6 and 10 recite “transmits the corrected image and image data simultaneously to the image recording section" which is missing from the application as originally filed.

Claim 11 recites “transmits the corrected image and image data sequentially to the image recording section” which is missing from the application as originally filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase “records at least either one of a set of image and information capable of reproducing the original image and the original image a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data” does not make any sense. For example, what is "a set of image?" What is “information capable of reproducing the original image and the original image?" What is “a set of image and information?" Claim 4 has the same problem.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 7,035,462 issued to White et al. (“White”).

For claim 1, White discloses an image data input section that enters image data representative of an original image (scanner 64 in figure 10); an image correcting section that applies a predetermined correcting processing to the original image represented by the image data entered through the image data input section to create corrected image (red-eye correction algorithm shown in figure 11); and an image recording section that records the corrected image subjected to the correcting processing in the image correcting section onto a first external media (output image from printer 61 of figure 10) for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data (output image from printer 61 of figure 10), and records at least either one of a set of image and information capable of reproducing the original image and the original image onto a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data (column 14, the pixel information can be the corrected pixel information and/or the pixel information previous to being corrected and stored in external media such as memory card 28 as shown in block 126 of figure 11, or images can be uploaded or downloaded as described in column 12 lines 30-35).

For claim 2, White discloses the image correcting section applies a red-eye correcting processing to the original image (figure 11).

For claim 3, White discloses the image data input section enters a photographic image, and the image recording section records the corrected image into a photographic print, and records the set of image and information onto a medium for recording digital data (see figure 10 and column 14).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over White.

For claim 4, White discloses the image data input section enters a photographic image, and the image recording section records the corrected image into a photographic print, or records at least either one of the set of image and information and the original image into a photographic print (see figure 10 and columns 12-13, the user can accept the corrected image for printing and can reject the corrected image to print the original image).

The Supreme Court has held that in analyzing the obviousness of combining elements, a court need not find specific teachings, but rather may consider “the background knowledge possessed by a person having ordinary skill in the art” and “the

inferences and creative steps that a person of ordinary skill in the art would employ." *See KSR Int'l v. Teleflex Inc.,* 127 S.Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). To be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions." *Id.* Here the combination is the predictable use of printing a corrected image onto a print followed by the predictable use of printing the original image onto a print. One of ordinary skill in the art at the time of invention would expect to be able to print both the original image and the corrected image using the kiosk of White by first rejecting the red-eye correction and printing the original image onto a first print, then accepting the red-eye correction and printing the corrected image onto a second print as taught by White in figures 10-11 and columns 12-14 to achieve the predictable result of printing the original and corrected images.

Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of U.S. Patent Number 6,346,998 issued to Shiota et al. ("Shiota").

For claim 5, White discloses the elements of claim 1. Shiota discloses that the image correcting section transmits the corrected image and image data together to the image recording section (the image recording section 193 as shown in figure 3 does not actually record any images, but rather forwards the data from correcting section 192 to actual recording devices such as an electronic memory 165 or paper 30 as shown in figure 5. The disclosure is silent as to whether the substrate 190 is implemented as hardware circuitry, software executed by a processor, or a combination of hardware and

software. Given the fact that the disclosure is silent as to the specific implementation of the substrate 190, and given the fact that there is no patentable distinction between a hardware substrate and a substrate implemented as software running on a computer, and given the fact that paragraph 66 of the specification defines the image recording section in the functional terms of something that transmits corrected image data and original image data to external media, the computer 15 of Shiota as shown in figure 8 has an image correcting section that transmits the corrected image and image data together to an image recording section, or output port, of computer 15, (see column 8 lines 65-67) which then transmits the corrected image and image data to external media 5 and 6.

It would have been obvious to a person of ordinary skill in the art at the time of invention to transmit the corrected image and image data together to an output port for the benefit of increasing efficiency as taught by Shiota in col. 1 line 65-col. 2 line 13.

For claim 6, the combination of White and Shiota disclose thtat the image correcting section transmits the corrected image and image data simultaneously to the image recording section as discussed in the rejection of claim 5.

For claim 7, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data can be predictably achieved by printing the red eye corrected

image of White using the printer 5 shown in Figure 1 of Shiota and by storing the original red eye image of White (column 14 lines 1-50) in electronic form using the disk 6 of Figure 1 of Shiota.

For claim 8, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if the original image is printed, the corrected image data is output to the second external medium as electronic data can be predictably achieved by printing the original image that has red eye from White using the printer 5 of Shiota and electronically storing the red eye corrected image of White using the disk 6 of Shiota.

Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota in view of White.

For claim 9, Shiota discloses an image data input section that enters original image data representative of an original image (the scanner shown in figure 1 and discussed in col. 8 lines 1-14).

an image processing section that applies a predetermined processing to the original image data to create processed image data, and transmits the original and processed image data to the image recording section (see for example fig 1 which shows image processing means and fig. 8 which shows image data received by image recording section output port of computer 15).

an image recording means for recording one of a first processed image data subjected to the correcting processing and the first processed image data onto a first external media for recording one of an image perceived on a visual basis and a recording of corrected image as electronic data (see figure 1 printer 5), said image recording means for further recording one of the image data capable of reproducing the original image and the original image onto a second external media for recording one of an image perceived on a visual basis and a recording of the original image data as electronic data (see figure 1 disk 6).

Shiota does not explicitly disclose an image red eye correcting section that applies a red eye correction processing to the original image data to create red eye corrected image data.

White discloses the image processing section that is a red eye correcting process as discussed in the abstract. White also discloses the image processing section generates image metadata capable of reproducing the original image as discussed in col. 14. It would have been obvious to a person of ordinary skill in the art at the time of invention to use the red eye correction image processing of White in the image processing means 3b of Shiota and to use the metadata image processing that generates image data capable of reproducing the original image of White in the image processing means 3a of Shiota to achieve the predictable result of printing the red eye corrected image and storing the original image data electronically.

For claim 10, the combination of White and Shiota disclose the image correcting section transmits the corrected image and image data simultaneously to the image recording section because the image recording section is the output port of a computer system such as that shown in figure 8 of Shiota.

For claim 11, the combination of White and Shiota disclose the image correcting section transmits the corrected image and image data sequentially to the image recording section because the image recording section is the output port of a computer system such as that shown in figure 8 of Shiota.

For claim 12, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if said corrected image is printed, the original image data is output to the second external medium as electronic data can be predictably achieved by printing the red eye corrected image of White using the printer 5 shown in Figure 1 of Shiota and by storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota.

For claim 13, the image recording section records one of the corrected image or the original image as image recording on a visual basis onto a printing medium and if the original image is printed, the corrected image data is output to the second external medium as electronic data can be predictably achieved by printing the original image

that has red eye from White using the printer 5 of Shiota and electronically storing the red eye corrected image of White using the disk 6 of Shiota.

(10) Response to Argument

Regarding the rejection Under 35 U.S.C 112 first paragraph of claims 6 and 10 appellant argues:

"Appellants respectfully submit that the specification is clear in that the corrected image data and image data are transmitted simultaneously to the image recording section. Page 20, lines 22-26 of the specification recites that the corrected image data and photographic image data are transmitted together to the image recording section. Furthermore, FIG. 5 also depicts the simultaneous transmission of the image data and corrected image data from the image correcting section 192 to the image recording section 193. It would be inherent that if the image data and corrected image data were transmitted together then the data transmission would also be simultaneously transferred. Finally, to one of ordinary skill in the art, the term "together" is commonly known to mean 'at the same time, or simultaneously.' "

Figure 5 is a flow chart it shows that a corrected image and photographic image can be transmitted it does not contain any timing information or any other information describing how they are transmitted in relation to each other. It does not support simultaneous transmission.

Appellant states that the word "together" is the same as the word simultaneously. If this is the case why does applicant claim "simultaneously "and in two separate claims? These claims would then be duplicate claims if the scope was identical. Furthermore why does applicant cite "together" in claim 9 yet claim "simultaneous" and "sequential" in claims 10 and 11 respectively? Appellant is arguing that one word broad word is support for two separate embodiments.

Appellant cites the word “together" and argues that the word simultaneous is inherent in the word together. If this were true how can claim 9 claim together and claim 11 further claim sequentially? The examiner cannot agree with this assertion, the word together is much broader and much less specific then the word simultaneously (or sequentially). The word "together” implies only a lack of separation and/or some sort of collective grouping. For example the images could be sent “together” and sent serially (or sequentially) one after another without separation (as claimed in claim 11) or they could be sent simultaneously (as claimed in claim 10). However the word together does not show possession of either because neither embodiment is specifically disclosed.

Regarding the rejection Under 35 U.S.C 112 first paragraph of claim 11 appellant argues:

Appellants respectfully submit that the specification is clear in that the corrected image data and image data are transmitted sequentially to the image recording section. Appellants' specification teaches that an operator may designate the first external media and the second external media by using a mouse. (See page 25, lines 1-4). By using a mouse as taught in the specification, a user would not be able to designate both the first external media and second external media at the same time. Thus, by first designating a first media, and then designating a second media, the corrected image would first be sent to the first media and then the image data would be sent to the second media. Thus, by the operator designating the first external media and then the second external media, it is clear that the specification teaches the sequential data transmission.

Appellent argues that page 25 lines 1-4 disclose sequential transmission. The cited section appears to have little to do with transmission or the timing of transmission. The cited section only refers to designating external media. The Examiner disagrees that designating first and second external media with a mouse, discloses sequential

transmission. Selection is not the same as transmission for example nothing could be transmitted until after both are selected.

Furthermore the transmission claimed in claim 11 (depending from claim 9) has nothing to do with transmission to external media. Claim 9 claims transmitting between the image correction section and image recording means which are both located on same substrate according to paragraph 48 of the specification and also Figure 3. Not transmission to any external media

Paragarph 48: “The image correcting processing substrate 190 comprises: an image data input section 191 for entering photographic image data obtained in the scanner section 110 or photographic image data stored in the small type of recording medium 163; an image correcting section 192 for applying a predetermined image correcting processing to the photographic image data entered through the image data input section 191 to create corrected image data; and an image recording section 193 for transmitting corrected image based on the corrected image data created in the image correcting”

Regarding the rejection Under 35 U.S.C 112 second paragraph of claim 1 appellant argues:

The Examiner alleges that in claim 1, the phrase "records either one of a set of image and information capable of reproducing the original image and the original image on a second external media for recording an image in form of at least either one of an image recording on a visual basis and a recording by image data", does not "make any sense" to the Examiner.
Appellants respectfully submit that "a set of image and information capable of reproducing the original

image" refers to the image recording section 197 transmitting the "corrected image" and "correction information" to the FD 165 as seen in FIG. 6. (See also, page 23, line 17 - page 24, line 5). Furthermore, the claim feature "original image" refers to "photographic image" that is transmitted from the image recording section 193 to the FD 165 as seen in FIG. 5. And finally, the claim feature "for recording an image in form of either one of an image recording on a visual basis and a recording of image data" refers to either the recording of the image on photographic paper or data storage. (See page 23, lines 11-22). Thus, the claims specify printing or storing uncorrected images to a first medium (print or data); and printing or storing corrected images and correction information to a second medium without being unduly limiting to the claims. The claims describe the features in basic Markush form. Thus the terminology used in the independent claims are sufficiently clear and the claims meet all requirements of 35 U.S.C. § 112 second paragraph.

The examiner disagrees with applicants assertion that "…ethier one of a set of image and information capable of reproducing the original image and the original image" makes sense. First the claim does not appropriately assign modifiers, and the claim uses the phrase "set of" in a way that makes no sense. Is it a set of images? or a set of information? Why is images not plural? (It appears to the examiner appellant may intend this to mean "a set comprising an image and…") Does "capable of reproducing" modify the information, the image or the set? Does "and the original image" modify the set or said "either one" After review appellants argument and explanation what appellant intends the claim to read something similar to "records either an original image or a set of information comprising, an image and information capable of reproducing the original image, onto" However the fact that appellant can give an explanation of what he intends the claim to mean as above does not make the claim language clear.

The examiner further disagrees that the feature "for recording an image in form of either one of an image recording on a visual basis and a recording of image data." First the phrase "in form of" is grammatically incorrect. Second image recoding on a visual basis makes no sense. What is a visual basis, how is "photographic paper" a "visual

basis"? Furthermore "recoding an image in form of… recording of image data" makes no sense. How is "recoding image data" a particular form of "recording an image"? After review applicants arguments perhaps appellant intends "recording the image in a visible form and recoding the image in an electronic form." However the fact that appellant can give an explanation of what he intends the claim to mean as above does not make the claim language clear.

Regarding the rejection of claim 1 with respect to 35 U.S.C. 102 Appellant Argues:

As an initial matter, the rejection is legally incorrect. Printer 61 cited by the Examiner corresponds to a kiosk embodiment of FIG. 10. Memory 28 cited by the Examiner corresponds to a digital camera embodiment of FIG. 1. The different embodiments may not be combined in the absence of a motivation to do so. There is no basis to combine operations of a camera with those of a print kiosk. Federal Circuit case law indicates that the rejection is legally improper. The Examiner may not alter or combine embodiments without a basis to do so. See Ex parte Beuther, 71 USPQ2d 1313, 1316 (BPAI 2003); and Net MoneyIN, Inc. v. Verisign, Inc., U.S. No. 2007-1565 (Fed. Cir. Oct. 20, 2008), (holding that an Examiner is not permitted to use multiple embodiments of a reference as a basis for anticipating a single claim).

The Examienr notes that a "memory card" is common to both embodiments (see column 12 lines 20-25 and column 5 lines 25-30). Therefore there is no issue with the memory card also belong to the camera embodiment. Furthermore as described below the memory card is one example of many possible elements of White which read on the second external media as described in claim 1.

Applicant also argues :

To the extent that the Examiner continues to rely on metadata to provide uncorrected (original) image data, there is no basis to conclude that the storage of the metadata is to a second external medium. For

instance, the media interface 68 is a read device and does not inherently have a record (store) feature. Metadata can also be associated with an internal memory. For example, the controller 67 inherently has an internal memory. Any metadata can be stored there. There is no inherent storage of the cited data to an external medium. The rejection of claim 1 therefore should be withdrawn.

The examiner disagrees applicants notion that image file and "metadata" is not described as stored to an external media. It is clear from column 12 lines 30-35 that any picture data may be transmitted to and stored by any number of external media (note images can be uploaded and downloaded) including prints by other printers then the printer 61 which the Examiner relies on to generate the first external media. Therefore the second external media could interpreted as printed images generated by different printers or memories of other computers to which the pictures have been download/uploaded.

While the “removable media” is not expressly described as storing output images from the Kiosk of White such storage is certainly implied because the removable media is the only storage device expressly disclosed by White to which the image file including metadata could possibly be stored.

Appellant has provided no evidence that controller necessarily contains an on chip (which is allegedly not external according to applicant) cashe capable of storing the image file described on column 14 (ie. the entirety of the image and the metadata) such statements are mere allegations. Even compressed images (stored by JPEG as described in column 14) are typically on the order of megabytes and the kiosk is

designed to handle multiple images. Clearly White does not intend to store these images in on chip cashe of the controller. Furthrmore even if these images were stored in an on chip cashe as described above the cashe would be external to the processing sections of the controller and therefore still external media in a sense that they are external to other potions of the controller chip. Appellant has not defined in any way what the "media" is "external" to.

Furthermore in the case the second external media is not the printer itself but the prints they generate so the first and second external media could be just different prints (i.e. original or corrected) from the same printer. Note a image is not recoded "onto" a printer but onto paper generating a print. Since the recording section of the kiosk is capable of printing images with or with out correction (see column 13 lines 10-13 note the corrections can be rejected) the first external media could be a print of the corrected image and a second external media could be a print of a uncorrected image. The fact that the same printer would create these two different media is irrelevant.

Regarding the rejection Under 35 U.S.C 103 of claim 4 appellant argues:

For claim 4, the rejection is even more defective because the citation is from a deficiency of the prior art to teach a concededly missing aspect of claim 4. The KSR case cited by the examiner does not excuse the Examiner from providing a rational supportable basis for a combination. Here, it is neither rational or supportable to cite a defect in the prior art to provide any kind of improvement to the disclosed embodiment. The rejection of claim 4 should be withdrawn.
White teaches printing the images one at a time. (See Fig. 11). White, however, does not teach or suggest photographic prints of both the corrected image, and the set of image and information or the

original image. The Examiner's hypothetical operation of White simply does not support the rejection since it is speculative. A prior art rejection cannot be premised on unsupported assumptions or probabilities. In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999). Similarly, the rejection is again legally unsupportable by its premise on a hypothetical operation not taught or suggested. The mere fact that a reference can be modified does not make the resultant modification obvious unless the prior art also suggests the desirability of the modifications. See In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Thus, White does not disclose or teach, "the image recording section records the corrected image into a first photographic print, and records at least either one of the set of image and information and the original image into a second photographic print" of the claimed invention.

The Examiner disagrees with several of appellants statements above. In light of KSR case discussed above the Examiner need not show “a defect”, “an improvement”, or "desirability of the modifications” to show an invention is obvious the combination may just be a predictable use of prior art elements according to their established function. *See KSR Int’l v. Teleflex Inc.,* 127 S.Ct. 1727, 1740-41, 82 USPQ2d 1385, 1396 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.*

Appellant does not challenge that White is capable of printing the original image (The corrections are rejected column 13 lines 10-12) or that White is capable of printing the corrected image (see column 13 lines 30-40). The difference between White and the claim is that White discloses printing either the original or the corrected image while the claim discloses recoding (e.g. printing) both. One of ordinary skill in the art is easily capable combining each alterative as taught by White and perform both printing operations. Such a combination would be well within the skill of one of ordinary skill in the art (they need only to instruct the kiosk print the original image and instruct the kiosk to print the corrected image) and the results printing both images are clearly

predicable (printing both original and corrected image). A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

Regarding the rejection Under 35 U.S.C 103 of claims 5-8 appellant argues:

Appellants note that the Examiner has not responded to the patentability arguments regarding claim 5 set forth at pages 3 and 4 of the Amendment filed on July 21, 2008. Nevertheless, Shiota teaches the image handling apparatus 15 is a general purpose computer with dedicated software installed. (See col. 10, lines 53-55). The Examiner argues that a computer with the proper software programming and hardware discloses "the image correcting section" of the claimed invention. The Examiner's reliance on FIG. 8, general purpose computer 15, however, is too general to teach the specific elements of claims 5. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). FIG. 2 of Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted together in Shiota as described in claim 5 of the present invention.

Appellant is comparing the claim to improper portions of Shiota. Appellant is comparing the “image recording apparatus” to the devices printer and disk drive of Shiota. These devise are infact the external media devices. The “Image recording section” of Shiota is part of the image handling apparatus namely the “image recording section” of Shiota is interpreted as is an output equipment/ports including any and all output ports necessary to transmit to the printer and disk drive shown in figure 8. That data is sent to the collective output ports together (see column 8 lines 65 and 67) As in applicants disclosure (see paragraph 43 and figure 5 of applicants) where in the “image recording section 193” appears to be the collection of necessary output ports/equipment to divide the data and send it to the appropriate external media devices. As described in paragraph 48 the image correcting section and the image

recording section are actually part of the same chip (substrate) so this claim feature merely describes the transfer of data from one section of a single computing device to another section of a single computing device. In Shiota two images are transferred from the processor to the output equipment/ports which are collectively the “image recording section”. Note in figure 5 of the specification after the portions are received by the recording section of the “image correrting processing substrate” the image recording apparatus divides the “original" image (or corrected image with data describing how to reverse the correction) and “corrected” image to send them along different transmission paths to the external media devices.

The examiner further notes applicant has a continually shifting notion of the word together, again together is a broad word that could interpreted any number of ways the data need only to be grouped in some fashion *column 8 lines 65-67 actually states the outputs are carried out together*.

Furthermore is unclear that “transmission" of claim 5 is even a physical transmission as described in applicants that takes places. The "input section” “image correction section” and “recording section” appear to be no more then functional description of operation of a hardware device. It is not clear if there is even any actual physical transmission disclosed in the specification or just a functional shift from one type of processing to another occurs. I.e. the correction section and recording section may merely be different operations of the same processor accessing the same data.

Regarding the rejection Under 35 U.S.C 103 of claims 7 and 8 appellant argues:

Specifically, the Examiner has not responded to Appellants' arguments that Shiota does not allow for the uncorrected data processes as described by claims 7 and 8, and that one of ordinary skill in the art at the time of the presently-claimed invention would not have been motivated to combine White and Shiota as suggested by the Examiner because there is no suggestion of motivation for doing so in the references themselves or the knowledge available to one of ordinary skill in the art without resorting to impermissible hindsight.

Claims 7 and 8 describe alternative printing or data storage of corrected and original data. However, it is clear from FIG. 2, that all data stored or printed in Shiota is corrected data. Shiota discloses in FIG. 2 that all data stored or printed is processed data (corrected data). Alternatively, White teaches correcting for eye color defects but does not disclose storing an original image to external media. (See Abstract). The Examiner asserts that, "storing the original red eye image of White in electronic form using the disk 6 of Figure 1 of Shiota" would have been obvious "for the benefit of increasing efficiency". However, FIG. 2 of Shiota teaches that all images stored in element 6 are processed data (corrected data). Thus, Shiota does not allow for the uncorrected data (original image) processes as described by claims 7 and 8. Because of the disparity between these two references, the only possible motivation for the Examiner's proposed combination is Applicant's own disclosure, the reliance on which constitutes impermissible hindsight reconstruction under MPEP §2143 (see also In re Vaeck, 20 USPQ 1438 (Fed. Cir. 1991)).

Regarding applicants arguments regarding the combination applicant is arguing both references separately. As stated above in applicants arguments Shiota discloses storing images to two external media (printer and electronic storage) whether or not both of these images have been corrected is irrelevant because White teaches storing the original image. Contrary to applicants arguments White discloses electronically storing a digital copy as the original image with meta data describing the corrected image pixel data(see column 14 lines 10-40). Therefore White does disclose storing an original image weather or not said storing is to an external device is irrelevant because Shiota discloses this feature.

Regarding motivation the examiner has provided motivation for the combination “increase efficiency” by generating both a providing both a printed and digital version. Applicant has done nothing more then allege impermissible hindsight. The fact that the references have differences does not preclude their combination by on of ordinary skill in the art. White describes digitally storing a uncorrected image along with meta data describing corrections to the image Shiota describes generated a corrected printed image together with an digitally stored image to “increase effciency" of processing. Such a modification of White to print the corrected image as well as store the original image as described in column 14 would be simple and the advantages clear.

Regarding the rejection Under 35 U.S.C 103 of claim 9 appellant argues:

FIG. 2 of Shiota, shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted together as described in claim 5 of the present invention, and Shiota does not disclose or suggest "transmits the corrected image data and original image data together" as recited in the claimed invention.

This argument is substantially similar to those presented with respect to claim 5.

Appellant is comparing the claim to improper portions of Shiota. Appellant is comparing the “image recording apparatus” to the devices printer and disk drive of Shiota. These devise are infact the external media devices. The “Image recording section” of Shiota is part of the image handling apparatus namely the “image recording section” of Shiota is interpreted as is an output equipment/ports including any and all output ports necessary to transmit to the printer and disk drive shown in figure 8. That data is sent to the collective output ports together (see column 8 lines 65 and 67) As in

applicants disclosure (see paragraph 43 and figure 5 of applicants) where in the "image recording section 193" appears to be the collection of necessary output ports/equipment to divide the data and send it to the appropriate external media devices. As described in paragraph 48 the image correcting section and the image recording section are actually part of the same chip (substrate) so this claim feature merely describes the transfer of data from one section of a single computing device to another section of a single computing device. In Shiota two images are transferred from the processor to the output equipment/ports which are collectively the "image recording section". Note in figure 5 of the specification after the portions are received by the recording section of the "image correrting processing substrate" the image recording apparatus divides the "original" image (or corrected image with data describing how to reverse the correction) and "corrected" image to send them along different transmission paths to the external media devices.

The examiner further notes applicant has a continually shifting notion of the word together, again together is a broad word that could interpreted any number of ways the data need only to be grouped in some fashion *column 8 lines 65-67 actually states the outputs are carried out together*.

Furthermore is unclear that "transmission" of claim is even a physical transmission as described in applicants that takes places. The "input section" "image correction section" and "recording section" appear to be no more then functional

description of operation of a hardware device. It is not clear if there is even any actual physical transmission just a functional shift from one type of processing to another occurs. I.e. the correction section and recording section may merely be different operations of the same processor accessing the same memory.

Regarding the rejection Under 35 U.S.C 103 of claim 9 appellant argues:

Shiota discloses that the processed image is stored on the recording medium 6. (See col. 11. lines 2-5). Shiota does not allow for the uncorrected data processes as described by claims 9. Thus, Shiota fails to teach or suggest an "image data capable of reproducing the original image", or "the original image onto a second external media for recording one of: an image perceived on a visual basis and a recording of the original image data as electronic data," as recited in the claimed invention.

These arguments are substantially similar to those presented for claim 7.

Shiota discloses storing images to two external media (printer and electronic storage) whether or not both of these images have been corrected is irrelevant because White is relied on to teach storing of the original image. Contrary to applicants arguments White discloses electronically storing a digital copy as the original image with meta data describing the corrected image pixel data (see column 14 lines 10-40).

White describes digitally storing a uncorrected image along with meta data describing corrections to the image Shiota describes generated a corrected printed image together with an digitally stored image to “increase effciency" of processing. Such a modification of White to print the corrected image as well as store the original image as described in column 14 (along with other data regarding the corrected image column 14 lines 1-20) would be simple and the advantages clear.

Regarding the rejection Under 35 U.S.C 103 of claims 10 and 11 appellant argues:

Claim 10 recites in part, "image correcting section transmits the corrected image and image data simultaneously to the image recording section". Claim 11 recites in part, "the image correcting section transmits the corrected image and image data sequentially to the image recording section". The Examiner asserts that both claims 10 and 11 are disclosed in FIG. 8 of Shiota. Appellants disagree with the Examiner's position.

FIG. 8 of Shiota shows a computer connected to a printer 5 and storage medium 6. Shiota, however, is silent on whether the data is transmitted together to the printer 5 and storage medium 6. (See col. 11, lines 1-5). But, FIG. 2 of Shiota clearly shows that an output of an image processing means 3 will separate the image (printer path 7) from the image data (medium path 6). Thus, the data cannot be transmitted simultaneously or sequentially in Shiota as described in claims 10 and 11 of the present invention.

Appellants also submit that the Examiner has cited the same reference and elements in Shiota as anticipating both claims 10 and 11. Assuming arguendo, that Shiota does disclose transmitting the corrected image and image data together to the printer and storage medium, it would not follow that Shiota would also disclose both the simultaneous and sequential transmission of corrected image and image data. Thus, Appellants submit that the same Shiota reference and citations could not disclose both claims 10 and 11. At least one of claims 10 or 11 should be patentable.

First the examiner points out that the "simultaneous" or “sequential” transmission of the claim as discussed previously is not transmission to an external media but the transmission from one section of the procession substrate 190 to another section of the processing substrate. Therefore applicants description of the transmission to the external media in Shiota is irrelevant.

The examiner points out that applicant uses the word a single word “together” to allegedly provide written description for both simultaneous and sequential transmission.

(See Arguments filed on 7/21/2008.) As Shiota also uses the word together (see column 8 lines 65-67). According to applicants arguments it must also discloses both of these features.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Sean Motsinger/

Conferees:

/Bhavesh M Mehta/

Supervisory Patent Examiner, Art Unit 2624

/Brian P. Werner/

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